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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/978,134

10/15/2001

Bradford Evan Gliner

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06/23/2004

PERKINS COIE LLP

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EXAMINER

BRADFORD, RODERICK D

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/978,134

Applicant(s)

GLINER ET AL.

Examiner

Roderick Bradford

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15 and 17-31 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6-9.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 1-14 and 32-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 15.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15, 17-19, 30 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Mann U.S. Patent No. 6,622,048.

Referring to claim 15 Mann discloses a method of automatically determining a favorable neuro-stimulation program for a patient comprising: applying an electrical stimulus having a plurality of stimulus parameters to a selected configuration of the therapy electrodes that have been installed at a target site, sensing a response to the applied electrical stimulus at a sensing device that has been installed at a sense location, determining whether the response is within a desired range or an improvement over a previous sensed response from a different electrical stimulus and/or a different

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configuration of therapy electrodes, selecting an alternate configuration of electrodes and/or an alternate electrical stimulus, repeating the applying, sensing and determining procedures using an alternate configuration of electrodes and/or the alternate electrical stimulus and choosing a configuration of therapy electrodes and/or an electrical stimulus corresponding to a sensed response that is within a desired range and/or provides a better result compared to others (column 4, lines 15-40).

Referring to claim 17, wherein the selecting procedure comprises computing an alternate electrode configuration while maintaining constant stimulus parameters, and wherein the computing the alternate electrode configuration comprises correlating a plurality of sensed responses with corresponding electrode configurations to which the constant stimulus parameters were applied to determine an electrode-configuration/response trend to estimating a new electrode configuration that is expected to improve efficacy according to the electrode-configuration/response trend (column 21, lines 36-55).

Referring to claim 30, wherein the data comprises coordinates of neural activity relative to the therapy electrodes (abstract and column 6, lines 39-41).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al. U.S. Patent No. 6,622,048.

Referring to claims 20-27 Mann discloses the claimed invention except for the specified times as stated by applicant. It would have been an obvious matter of design choice to one skilled in the art to modify the teachings of Mann to include the different specified times, since applicant has not disclosed that the specified times provides any criticality and/or unexpected results and it appears that the invention would perform equally well with any specified time, such as the time as used by Mann, as a means for configuring the electrodes to provide appropriate stimulation.

7. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al. U.S. Patent No. 6,622,048 in view of John et al. U.S. Patent No. 6,463,328.

Referring to claims 28 and 29, Mann fails to disclose wherein the sensing

procedure comprises attaching EMG sensors to a sense site of the patient, detecting peripheral responses to the stimuli applied to the electrodes, and automatically sending the detected peripheral responses to the controller and wherein the sensing procedure comprises detecting data related to neural activity using a functional MRI and automatically sending the data to the controller. However, John discloses attaching EMG sensors to a sense site of the patient, detecting peripheral responses to the stimuli applied to the electrodes, and automatically sending the detected peripheral responses to the controller (column 4 line 59 – column 5 line 40) and wherein the sensing procedure comprises detecting data related to neural activity using a functional MRI and automatically sending the data to the controller (column 6, lines 7-26 and 48-54) as a more efficient means for obtaining data.

It would have be obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Mann to include attaching EMG sensors to a sense site of the patient, detecting peripheral responses to the stimuli applied to the electrodes, and automatically sending the detected peripheral responses to the controller and wherein the sensing procedure comprises detecting data related to neural activity using a functional MRI and automatically sending the data to the controller, as taught by John, as a more efficient means for obtaining data.

***Allowable Subject Matter***

8. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

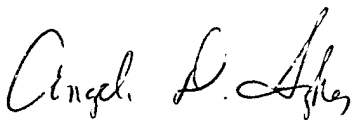
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Bradford whose telephone number is (703) 305-3287. The examiner can normally be reached on Monday - Friday 7 a.m. - 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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